

## **REMARKS**

This is a full and timely response to the final Office Action of May 27, 2003.

Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested. Upon entry of this First Response, claims 1-23 are pending in this application.

### **Response to Examiner's Arguments**

The Office Action asserts that "*Mori* teaches a printer driver that converts print data into information in print-ready-format," and the Office Action asserts that "*Housel et al.* teaches a printing device that enables to select a portion of a print job." See Office Action at page 5. Applicant respectfully traverses such assertion.

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In this regard, *Housel* specifically teaches that a user inputs "media feed instructions" that "[t]he central processing unit 17 converts" from "one table or database...into printer-readable language for the printer 18 or instructions for controlling the printing operation and the direction of the pages from the at least one input source 38 to one or more output destination sources 39." See *Housel*, paragraph 51 and 52. It does not appear, however, to teach or suggest "enabling a selected portion of the information in the print-ready format to be printed."

Further, the Office Action cites paragraphs 59-61 to support its assertion that *Housel* teach or suggests enabling a selected portion of a print job. *Id.* However, Applicant is unable to find in these cited paragraphs where the device enables a selected portion of "the information in print-ready format to be printed." Specifically, paragraph 59 indicates that a user can "request to use only some fraction of the ordered media" by entering a command referring to such request. See *Housel*, paragraph 59. The command associated with this request is stored in a table or a database, and the central processing unit converts the table or database into printer-readable language. See *Housel*, paragraph 51-52.

Likewise, a user of the printing system taught in *Housel* also provides commands that allow a user to “request to send un-needed sheets to a specified...output destination” or to “request to route ... ordered media to one of the output destinations. See *Housel*, paragraphs 60-61. However, as described hereinabove, a user performs such function by selecting “one or more different commands...to instruct the...system...to provide a document with a desired appearance or configuration.” See *Housel*, paragraph 58. In this regard, the above identified requests are “organize[d] into a table or data base” that the “central processing unit converts...into printer-readable language.” See *Housel*, paragraph 51-52.

In light of the foregoing, Applicant submits that *Housel* teaches allowing a user to select media feed instructions related to a print job. However, Applicant further submits that *Housel* does not teach or suggest “enabling a selected portion of the information in print-ready format to be printed.”

### **Response to §103 Rejections**

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, “(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Furthermore, the Federal Circuit has stated that “(i)t is impermissible, however, to simply engage in hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (1991).

## Claim 1

Claim 1 presently stands rejected under 35 U.S.C. §103 as purportedly being unpatentable over *Mori* in view of *Housel*. Previously presented claim 1 reads as follows:

1. A method for printing information comprising:  
storing information corresponding to a print task in memory in a print-ready format, such that information in the print-ready format can be printed by a printing device without being processed by a driver; and  
***enabling a selected portion of the information in the print-ready format to be printed without printing a non-selected portion of the information in the print-ready format.*** (Emphasis added).

Applicant respectfully asserts that the cited art is inadequate to render pending claim 1 obvious. In particular, the cited art fails to suggest or teach at least the features of pending claim 1 highlighted hereinabove.

The Office Action states that “*Mori* does not specifically teach ...[a] job retention system... configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information.” See Office Action, page 2. However, the Office Action asserts that *Housel* does teach a printing system exhibiting this feature, and Applicant respectfully traverses this assertion.

In this regard, *Housel* appears to generally teach a printing system that permits a user to select portions of a print task to be printed on selected mediums. However, it does not appear that the print task is “information in print-ready format.” To the contrary, *Housel* specifically teaches allowing a user to select print task pages and associated mediums at the printer interface, and thereafter, the “central processing unit 17 converts the information ...into printer-readable language for the printer.” See *Housel*, paragraph 52, lines 5-10.

Therefore, it does not appear that the alleged combination teaches or suggests “enabling a selected portion of the *information in the print-ready format* to be printed without printing a non-selected portion of the information in the print-ready format,” as claimed in claim 1. (Emphasis added). Accordingly, Applicant submits that the Office Action fails to overcome its burden of establishing that each of the combination of features highlighted hereinabove for claim 1 is suggested or taught by the cited art.

For at least the foregoing reasons, Applicant submits that the 35 U.S.C. §103 rejection of claim 1 is improper and should be withdrawn.

### **No Motivation to Combine**

In addition, in rejecting pending claim 1, it is asserted in the Office Action that:

“[I]t would have been obvious to one having ordinary skill in the art to modify *Mori* to permit portions of the print-ready information to be selected and printed since *Housel et al.* teaches that enabling a selected portion of a print job to be printed is beneficial for permitting a user to more easily designate the print jobs.”

However, Applicant respectfully continues to assert that this alleged motivation for combining *Mori* with *Housel* is inadequate.

In this regard, the Office Action fails to cite a specific teaching in the cited art showing that the alleged motivation for combining *Mori* with *Housel* is suggested by the cited art. “There must be some reason, suggestion, or motivation *in the prior art* whereby a person of ordinary skill in the field of the invention would make the combination.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992)(emphasis added). Moreover, Applicant submits that the aforementioned reason proffered in the Office Action for combining *Mori* with *Housel* is not gleaned from the cited art but is instead based on improper hindsight reconstruction of Applicant’s invention. As a result, the combination of *Mori* and *Housel* to reject pending claim 1 under 35 U.S.C. §103 is improper.

### Claims 2-9 and 21-23

Claims 2-9 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Mori* in view of *Housel*. Further, claims 21-23 have been newly added via the amendments set forth herein. Applicant submits that the pending dependent claims 2-9 and 21-23 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-9 and 21-23 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### Claim 10

Claim 10 presently stands rejected under 35 U.S.C. §103 as purportedly being unpatentable over *Mori* in view of *Housel*. Previously presented claim 10 reads as follows:

10. A print system comprising:  
a job retention system configured to store print-ready information corresponding to a print task and to receive an input corresponding to a selected portion of the print-ready information, the print-ready information being configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device, ***the job retention system being further configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information.*** (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that the cited art fails to suggest or teach at least the features of claim 10 highlighted hereinabove. Therefore, the 35 U.S.C. §103 rejection of claim 10 is improper and should be withdrawn.

### **Claims 12-20**

Claims 12-20 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Mori* in view of *Housel*. Further, claim 22 has been added via the amendments set forth herein. Applicant submits that the pending dependent claims 12-20 and 22 contain all features of their respective independent claim 10. Since claim 10 should be allowed, as argued hereinabove, pending dependent claims 12-20 and 22 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

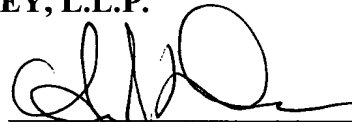
### **CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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